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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,988

10/05/2005

Gerhard Hamprecht

3165-137

6444

6449

7590

01/02/2009

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

1425 K STREET, N.W.

SUITE 800

WASHINGTON, DC 20005

EXAMINER

MABRY, JOHN

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

01/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,988	<b>Applicant(s)</b> HAMPRECHT ET AL.	
	<b>Examiner</b> JOHN MABRY	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16, 17 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) 20, 21 and 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/26/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment(s)***

Applicant's remarks on September 26, 2008 regarding Election/Restriction dated March 14, 2008 has been received and duly noted. The Examiner acknowledges Applicants' arguments that intermediate of compound I and process of claim 20 should be rejoined. Examiner maintains that Restriction Requirement was proper and remains final.

Applicant's response on September 26, 2008 filed in response to the Office Action dated May 27, 2008 has been received and duly noted.

In view of this response, the status of the rejections/objections of record is as follows:

***Status of the Claims***

Claims 16-17 and 22-23 are pending and rejected.

Claims 18-19 and 28-39 have been cancelled.

Claims 20-21 and 24-27 are directed towards non-elected subject matter.

***35 USC § 112 Rejection(s)***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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The 112-2<sup>nd</sup> rejection of claims 22-23 regarding “the intended use” have been overcome in view of Applicants amending the claims.

The 112-2<sup>nd</sup> rejection of claims 28-39 regarding the claims being omnibus have been overcome in view of Applicants cancelling the claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The 112-1<sup>st</sup> rejection of claims 16-19, 22-23 and 28-39 regarding the scope of enablement have been overcome in view of Applicants amending and cancelling claims.

### ***Claim Rejections - 35 USC § 103***

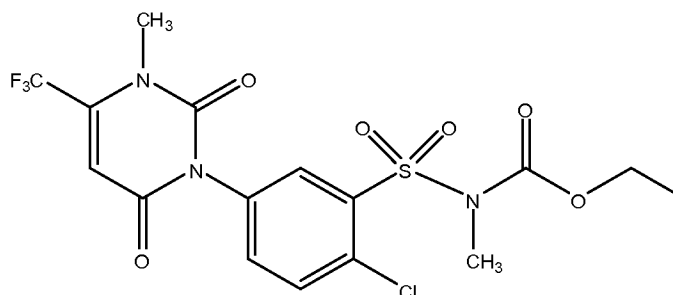
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19 and 22-23 rejections are maintained under 35 U.S.C. 103(a) as being unpatentable over Strunk et al (US 5,169,430).

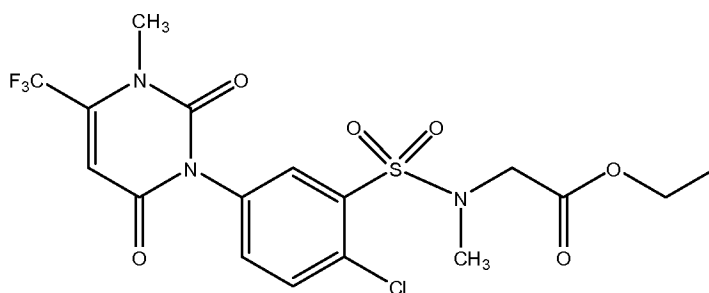
Applicant's arguments with respect to 103(a) rejections have been fully considered and are not persuasive. Applicant has not compared the closest art as clearly described in previous Office Action (see below).

The instant application claims compounds and pharmaceutical compositions of Formula I wherein X1/Y1=halogen, X3=CH3, Q=Q21, Y=-C(O)OC2H5.



#### ***Scope & Content of Prior Art MPEP 2141.01***

Strunk discloses compounds and pharmaceutical compositions of Formula I wherein X1/Y1=halogen, X3=CH3, Q=Q21, Y-R1=-C(O)O-C2H5 (see Compound No. 41, column 23/24, Table I).



#### ***Differences between Prior Art & the Claims MPEP 2141.02***

Strunk differs from the instant application at the -N-Y- position:

Strunk's -NCH3-CH2-CO2CH2CH5 versus Applicants' -NCH3-CO2CH2CH5

***Prima Facie Obviousness, Rational & Motivation MPEP 2142-2413***

An artisan of ordinary skill would be motivated to extend the -N-Y- position by one -CH<sub>2</sub>- group for a herbicidal use as a method of controlling weeds as disclosed by Strunk. The current application claims the same method of controlling unwanted vegetation using compounds of Formula I.

The MPEP 2144.09 which states: Compounds which are homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH<sub>2</sub>- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

compound A

compound B

Chemical structures of compound A and compound B are shown. Compound A is a triazine derivative with a trifluoromethyl group, two fluorine atoms, and a chlorine atom on the phenyl ring, and an acetamide group. Compound B is a triazine derivative with a trifluoromethyl group, two fluorine atoms, and a chlorine atom on the phenyl ring, and a propanamide group.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's primary examiner can be reached at (571) 272-0684, first, or the Examiner's supervisor, Janet Andres, PhD, can be reached at (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry/  
Examiner  
Art Unit 1625

/Rita J. Desai/  
Primary Examiner, Art Unit 1625



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